

REMARKS

This is in response to the Office action dated August 9, 2005, in which claims 1, 3-11, 13-20, 22-28, 31 and 33-43 were allowed, and claims 12 and 21 were rejected. The applicant is appreciative of the allowed subject matter. The applicant believes claims 12 and 21 are also in allowance, in view of the amendments and remarks herein.

Claim 12 Is In Condition For Allowance

The applicant has amended claim 12, and believes claims 12 as amended to be duly supported by the original application and in condition for allowance. In particular, claim 12 as amended includes subject matter similar to subject matter in claim 1, which has already been allowed. This provides one illustrative reason why claim 12 is also in condition for allowance. The applicant therefore requests reconsideration and allowance of claim 12, in view of the amendments and these remarks.

Claim 21 Is In Condition For Allowance

Claim 21 was rejected under §103(a) due to US patent 5,860,231 issued to Lee et al. ("Lee") combined with US patent 5,884,204 issued to Orbach et al. ("Orbach"). However, the applicant maintains that Lee and Orbach do not render claim 21 obvious, and asks the examiner to reconsider this rejection. Specifically, there would have been no motivation to combine the disclosures of Lee and Orbach, and further, Lee and Orbach are directed to different purposes and teach away from each other. Since "[v]irtually all inventions are combinations... of old elements" (Intel Corp. v. Int'l Trade Comm'n, 20 USPQ2d 1161, 1179 (Fed Cir. 1991) (cit. omitted)), distinctions of motivation to combine and teaching away deserve great weight in distinguishing combinations of elements that are inventive.

For example, neither Lee and Orbach, nor the common knowledge of those in the art or the nature of the problem to be solved, include a suggestion to combine the disclosures of

these two references as demonstrated by a specific factual inquiry of objective evidence. Even if Lee and Orbach were to disclose or suggest every element of claim 21 between the two of them, the claim is not shown to be obvious without such a specific fact finding that a person skilled in the art at the time of the invention of claim 21 would have had a motivation to combine the teachings of these two references. Such a specific fact finding from objective evidence has not been shown.

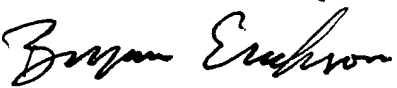
Further, Orbach teaches away from Lee and from the present invention, providing compelling evidence that a person of ordinary skill in the art at the time that claim 21 was invented would not have had motivation to combine the Lee and Orbach references. Specifically, Orbach discloses a system for restricting motion of an implement while the implement is inactive and while a machine on which it is mounted is traveling. It deals with preventing undesirable motions of an implement. In contrast, claim 21 includes an automatic vibration mechanism for causing the attachment member to vibrate automatically in response to an activation signal, wherein the automatic vibration mechanism comprises an algorithm. As defined by the claim language and as described in the specification, the subject matter of claim 21 is advantageous for actively working with the attachment member and causing the attachment member to vibrate. Orbach is thus very different in mechanism and in purpose from the teachings of claim 21, and from the teachings of Lee; the automatic vibration of a working member taught by Lee would work directly contrary to the purposes of Orbach. Since “[i]t is improper to combine references where the references teach away from their combination (MPEP §2145(X)(D)(2); In re Grasselli, 218 USPQ 769, 779 (Fed. Cir. 1983))”, the combination of Lee and Orbach does not properly show that claim 21 would have been obvious. On the contrary, claim 21 describes a new and unobvious invention.

Therefore, the applicant respectfully requests that the rejection of claims 12 and 21 be reconsidered, and that claims 12 and 21 be allowed.

The Director is authorized to charge any fee deficiency required by this paper or credit any overpayment to Deposit Account No. 23-1123.

Respectfully submitted,

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